

REMARKS

Claims 1-29 are pending in this application after this Amendment. Claims 1 and 11 are independent. In light of the amendments and remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

By this Amendment, Applicants have amended the claims without conceding the propriety of the Examiner's rejection, but merely to put the claims in a proper format that conforms to U.S. patent practice.

In the outstanding Official Action, the Examiner rejected claims 1-4, 7-9, 11-19, and 23 under 35 U.S.C. § 103(a) as being unpatentable over *Dow et al.* (USP 6,549,304) in view of *Fann* (USP 6,279,828); and rejected claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over *Dow et al.* in view of *Fann* and further in view of *Gobeli et al.* (USP 5,999,666). Applicants respectfully traverse these rejections.

**Claim Rejections - 35 U.S.C. § 103**

In support of the Examiner's rejection of claim 1, the Examiner asserts that *Dow et al.* discloses the processing device and the comparison device of the present invention, citing to col. 3, lines 5-8, and col. 8, lines 53-59. The Examiner admits that *Dow et al.* does not explicitly disclose the assembling device of the present invention. In order to cure the deficiencies of the teachings of *Dow et al.*, the Examiner relies on the teachings of

Fann, citing to col. 3, lines 1-23. Applicants respectfully disagree with the Examiner's characterization of these references.

The disclosure of *Dow et al.* is directed to a scanning appliance and method having user help capability. The system includes a help utility module that allows a user to obtain information on operating the various features of the appliance. Specifically, at col. 3, lines 5-8, *Dow et al.* discloses as follows:

According to another aspect of the invention, the help utility module includes code segments for displaying a textual dialog and still graphics or an animation that convey information correlated with the help topics.

Additionally, at col. 8, lines 53-59, *Dow et al.* discloses as follows:

FIGS. 13A and 13B demonstrate an incorrect capture path in which the user fails to overlap the two paths made across the target page thus failing to capture the entire image. Because a user must be able to successfully capture a page before the other features of appliance 22 can be fully utilized, this topic is chosen as the default in the help menu in the preferred embodiment.

In contrast, the present invention as set forth in claim 1, as amended, recites, *inter alia*, a device for recording information by obtaining at least two images of the information having partially overlapping contents comprising a processing device for converting the information in each of the images to a coded representation, a comparison device for comparing the coded representation of the

images for determining an overlap position between the images, and an assembling device including a memory for assembling the compared coded representation to form a composite representation in the memory. Applicants respectfully submit that at least those portions the Examiner relied upon to teach or suggest the processing device and the comparison device of the present invention are deficient.

As can be seen from the above citation, *Dow et al.* merely discloses correlating help topics with the appropriate textual dialog and still graphics or animation. These help topics assist a user in obtaining information on operating various features of the appliance. Figs. 13A and 13B demonstrate images that are presented to the user that advise the user of an incorrect capture path in which the user fails to overlap the two paths made across the target page, thus failing to capture the entire image. Applicants respectfully submit that this teaching is insufficient to disclose a comparison device for comparing the coded representations of the images for determining an overlap position between the images. This teaching is merely directed to a help feature and is not directed to a comparison device that is incorporated in a device for recording information.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be

some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Additionally, in order for the Examiner to rely on a prior art reference, it is necessary that the prior art contain an enabling disclosure. "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within § 102, the stated test is whether a reference contains an 'enabling disclosure'...." *In re Hoeksema*, 399 F.2d 269, 158 U.S.P.Q. 596 (CCPA 1968). A reference contains an enabling disclosure if the public was in possession of the claimed invention before the date of the invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his or her own knowledge and make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 U.S.P.Q. 619 (Fed. Cir. 1985).

It is respectfully submitted that there is no teaching or suggestion in *Dow et al.* that is directed to a comparison device for comparing the coded representation of the images for determining an overlap position between the images. Further, *Fann*

fails to teach or suggest this claim element, thus failing to cure the deficiencies of the teachings of *Dow et al.* As such, as neither of the references, either alone or in combination, assuming these references are combinable, which Applicants do not admit, teach or suggest this claim element, it is respectfully submitted that the Examiner has failed to satisfy his burden in establishing *prima facie* obviousness. As such, it is respectfully requested that the outstanding rejection be withdrawn.

In addition to the above argument, the Examiner admits that *Dow et al.* does not disclose assembling coded representation to form a composite representation. The Examiner relies on the teachings of *Fann* to cure the deficiencies of the teachings of *Dow et al.* Applicants respectfully disagree with the Examiner's assertions.

The disclosure of *Fann* is directed to one dimensional bar code patterns for encoding single and multi-byte characters. The method of generating the bar code pattern includes, as disclosed in *Fann* at col. 3, lines 13-24, as follows:

... choosing the base number code system; picking a code length between eight and sixteen for the chosen base number code system; generating all combination of the designated base numbers within the chosen base number code system having the chosen code length; assigning an image having a width measured in unit for each designated base number within the chosen base number code system; translating each designated base number within the chosen base number code system according to the assigned image thereby forming a bar code pattern;

and, selecting unambiguously decodable generated bar code patterns.

In contrast, the present invention as set forth in claim 1 recites, *inter alia*, an assembling device including a memory for assembling the compared coded representation to form a composite representation in memory. It is respectfully submitted that the disclosures of *Fann* are insufficient to cure the deficiencies of the teachings of *Dow et al.*

*Fann* merely discloses generating all combinations of the designated base numbers within the chosen base number code system having the chose code length and assigning an image for each designated base number within the chosen base number code system. There is no teaching or suggestion in *Fann* that is directed to assembling the compared coded representation to form a composite representation in memory. *Fann* merely assigns an image for each designated base number and forms the bar code pattern based upon this assignment. There is no assembling of compared coded representation as set forth in claim 1. As such, it is respectfully submitted that *Fann* fails to cure the deficiencies of the teachings of *Dow et al.* As such, it is respectfully submitted that the Examiner has failed to satisfy his burden in establishing *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements. As such, it is respectfully requested that the outstanding rejection be withdrawn.

Finally, in support of the Examiner's rejection of claim 1, the Examiner asserts that one of ordinary skill in the art would have been motivated to combine the teachings of *Fann* with the teachings of *Dow et al.* "to combine number codes for assigning an image having a width measured in unit for each designated base number within the chosen base number code system." Applicants respectfully disagree with the Examiner's assertions.

As noted above, *Dow et al.* provides for a help utility that allows a user to view text and images to assist in using a scanning device. In a non-analogous field, *Fann* discloses encoding single and multi-byte characters in the form of one dimensional bar code patterns. Applicants are confused by the Examiner's statement of motivation. Combining number codes for assigning an image having a width measured in unit for each designated base number within the chosen base number code system is not an element that is even remotely directed to the present invention. It is respectfully submitted that one of ordinary skill in the art would not look to the teachings of *Fann* to modify the teachings of *Dow et al.* as asserted by the Examiner.

*Dow et al.* is concerned with solving the problem of providing a portable handheld image capturing device that allows a user to process or manipulate captured images in the device and has the ability to communicate the images directly to some other unit. In contrast, *Fann* is directed to providing a system that allows for

the coding of non-English alphabet characters. These two references are directed to different problems to be solved and, as they incorporate non-analogous subject matter, it is respectfully submitted that these two references are not properly combinable.

It is respectfully submitted that claims 2-10 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1. It is further respectfully submitted that claim 11 contains elements similar to those discussed above with regard to claim 1, and thus claim 11, together with claims dependent thereon, are allowable for the reasons set forth above with regard to claim 1.

#### Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


Applicants respectfully petition for a one (1) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the amount of \$120.00 in payment of the extension of time fee is attached.




If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #39,491  
Michael K. Mutter, #29,680

  
MKM/CMV/jdm  
4830-0108P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000